

REMARKS

In the Examiner's Answer, the Examiner introduced a new ground of rejection. In response to a new ground of rejection made in an Examiner's Answer, Applicants can either (1) submit a Reply Brief that addresses the new ground of rejection; or (2) submit a reply in compliance with 37 CFR 1.111 to request that prosecution be reopened. MPEP 1207.03I. Applicants choose the second option and submit this Preliminary Amendment along with a request to reopen prosecution.

35 USC 101

The Examiner rejects claims 10-26 and 28-33 under 35 USC 101 for failing to recite a statutory process. Applicants amend claim 10 to recite "a computer comprising a processor and a memory, the processor configured to implement instructions stored in the memory." Applicants further amend claim 10 to recite that the steps are performed by a computer. Support for this amendment can be found, for example, on page 6, lines 24-33 and page 8, line 29. While the specification does not explicitly disclose a processor, Applicants submit that it is inherent that the client computers that are described in detail on page 6 use a processor coupled to a memory, such as the one described on page 8, to perform the steps recited in claim 10.

A claimed process is patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing. In re Bilski, 545 F.3d 943 (Fed. Cir. 2008 *en banc*). As amended, claim 10 recites steps that cannot be performed mentally, but instead are performed by the recited computer (a particular machine). As such, Applicants respectfully posit that the first prong of the

"machine or transformation test" is met, and thus each method claim is patent-eligible subject matter.

Furthermore, Applicant respectfully notes that claim 10 recites "interpreting, by the computer, the PDL commands to process each object in the print job," "determining, by the computer, if any of the at least one associated attributes matches any of the at least one determined attributes," and "reporting, by the computer the results of any matched object using the corresponding unique marker." In other words, the process **transforms** associated attributes (articles) that match the determined results (a different thing), into reported results using the corresponding unique marker. A reported result into which the data is **transformed** comprises, for example, a printed effect, an audio clip, *etc.* As a result, Applicants respectfully posit that the second prong of the "machine or transformation test" is also met, and that the rejection under 35 USC 101 should be withdrawn.

Because claims 11-26 and 28-33 depend directly or indirectly upon claim 10, they are patentable for at least the same reasons.

35 USC 102(e)

The Examiner rejects claims 10-12 and 28-29 under 35 USC 102(e) as being anticipated by Jackelen (USPN 6,823,147).

Before addressing Jackelen, Applicants will describe the subject matter recited in amended claim 10. Applicants reproduce below Figure 6A and portions of Figures 8 and 10 solely to aid the Examiner in understanding the subject matter.

Applicants amend claim 10 to recite a method “for analyzing a print job comprising a plurality of objects, each object comprising any of pages, text, images, and graphics, each object having at least one associated print attribute.” Support for this amendment can be found, for example, on page 2, line 18 of the specification. The method comprises determining print attributes of interest. This determined attribute can be, for example, the type of object, font name, font size, *etc.* A unique marker is associated with each determined attribute. The unique marker provides instructions on how to convert an object in a print job to a determined attribute, where a match is found between the determined attribute and the associated attribute in the print job. Page 10, lines 5-9 of the specification.

The computer receives and interprets PDL commands that describe a print job in order to process the objects in the print job. Recall that these objects include the associated attributes. To illustrate, Applicants refer the Examiner to page 100c from Figure 8 and Figure 6A:

section of Figure 8

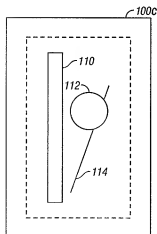


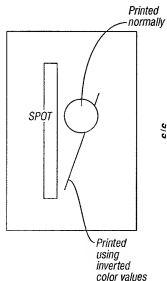
Figure 6A

PREDETERMINED ATTRIBUTE	ASSOCIATED MARKER
font name = Helvetica	replace color values with shades of cyan
font name = Arial and font size = 18 pt	replace color values with shades of magenta
color space = RGB	replace color values with shades of yellow
object = graphic and color value = Pantone 117	tag object with text "SPOT"
⋮	⋮
object = graphic and orientation = landscape	invert color values

In page 100c, 110, 112, and 114 are objects. Figure 6A describes the predetermined attributes (referred to as determined attributes in claim 10) and associated markers (referred to as unique markers in claim 10) for page 100c. For example, in page 100c object 110 has the determined attributes 72d of being a graphic, and having the color value Pantone. The unique marker 74d associated with the determined attributes 72d for object 110 is the text "SPOT."

The computer determines if any of the associated attributes for the object as described by the PDL commands match any of the determined attributes. In the example of page 100c, the associated attributes for 110 match the determined attributes 72d. The object 100 becomes marked with the unique marker 74d. The marking is reported, for example, by printing the object using the instructions represented by the unique marker. As noted above, the unique marker for object 110 is the text "SPOT." Figure 10 illustrates objects that are reported with the unique marker, *i.e.* with "SPOT" overlaid on the object:

Figure 10



Where associated print attributes do not match the determined attributes, the associated attributes are printed according to the PDL commands, *i.e.* without corresponding unique markers. See, for example, page 11, lines 1-8. In the example above, if the associated attribute "SPOT" did not match the determined attributes, object 110 would be printed without "SPOT" overlaid on the graphic.

The method recited in claim 10 avoids printing problems that result from the common practice of converting the PDL commands into another format. In the above example, a conversion of the PDL commands could result in printing "SPOT" in the wrong place, changing the location of the object 110, *etc.* See, for example, page 3, lines 13-23 of the specification. In the method recited in claim 10, on the other hand, either "SPOT" is printed correctly or not at all. As a result, even if "SPOT" is not printed, the object is printed without converting the PDL commands.

Turning now to Jackelen, Jackelen obtains information about printing attributes from the print job header. Column 4, lines 3-4. "[T]he print job header is parsed, and the print job attributes determined." Column 4, 2-3. The Examiner asserts that parsing a print job header to determine the print job attributes is equivalent to analyzing a print job comprising an object having an associated print attribute. However, the Examiner further equates the individual pages in a print job described in Jackelen with the objects recited in claim 10.

Applicants amend claim 10 to clarify. The objects in claim 10 "comprise any of pages, text, images, and graphics." For example, page 100c as illustrated in Figure 8 above, comprises three objects, each of which is a graphic. Thus, the object in claim 10 is not

equivalent to a single page in a print job as described in Jackelen. In Jackelen, the object is always only a single page, whereas in claim 10, the object is a page, text, image, and/or graphic depending upon the type of content contained in the print job.

In addition, Jackelen contains no teaching or suggestion of "each object having at least one associated print attribute." In Jackelen, the print attributes are determined directly from the job header. In claim 10, on the other hand, the PDL commands are interpreted to process the objects, where the objects include the associated print attributes.

In Jackelen, the method includes determining whether there is a mismatch between the print job attributes and the available printer resources, *i.e.* whether the printers are capable of fulfilling the printing requirements of the print job. Column 4, lines 6-8. The Examiner equates the "available printer resources" in Jackelen with the unique marker recited in claim 10; however, these are not equivalent concepts. The unique marker in claim 10 contains instructions for printing the determined attribute. It is not an available printer resource. Furthermore, in Jackelen, the available printer resources is a fluid concept "because printer resources may change while the job is being rendered." Column 2, line 52. A unique marker, on the other hand, is always associated with the same determined attribute.

Although the Examiner equates the "unique marker" with the "available printer resources" in one section, the Examiner equates the "determined attribute" with the "available printer resources" in another section. The "available printer resources" cannot represent both the "unique marker" and the "determined attribute" because these are different concepts in claim 10. Applicants refer the Examiner to Figure 6A, which illustrates that the unique marker is different from the determined attribute.

In Jackelen, if there are no mismatches between the print job attributes and the available printer resources, the pages are rasterized and then printed. Column 4, lines 16-29. In claim 10, on the other hand, the match is between the determined attribute and the associated attribute. The "available printer resources" cannot be equivalent to both the "unique marker" and the "associated attribute." As a result, Jackelen does not disclose or suggest a "unique marker."

Furthermore, in claim 10, if there is a match between the determined attribute and the associated attribute, the results of the matched object are reported using the corresponding unique marker. The unique marker identifies the presence of an object associated with the determined attribute in the print job. Page 10, lines 1-2. If there is a mismatch between the determined attribute and the associated attribute, the objects are still printed. This is in contrast to Jackelen, where a mismatch between the print attributes and the printer resources places the job on hold and halts the rendering. Column 4, lines 30-32.

Jackelen describes a situation that presents the types of problems that the subject matter recited in claim 10 is designed to avoid. Jackelen includes a rasterizing step, which "refers to a collection of programs that translates a job in PDL format into a series of rasterized images and media descriptors for printing the job." Column 2, lines 34-36. In claim 10, on the other hand, by only applying the unique marker to an object where the associated attribute matches the determined attribute, there is no need to convert from PDL commands to any other format. There is no opportunity to introduce a conversion error into the printing process. As a result, the objects are printed as intended.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Because Jackelen fails to expressly or inherently describe unique markers; a plurality of objects; interpreting with the processor the PDL commands to process each object in the print job and the at least one associated print attribute; reporting with the processor the results of any matched object using the corresponding unique marker; and printing the associated attributes that do not match any of the determined attributes according to the PDL commands, Jackelen does not anticipate claim 10. Because claims 11-33 depend directly or indirectly upon claim 10, they are patentable for at least the same reasons.

Conclusion

In view of the above, Applicants respectfully posit that the pending claims are allowable. The Examiner is invited to please contact Applicants' attorney at (650) 474-8400 should any questions arise.

Respectfully submitted,



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